

SALK1520-2 (088802-8752) 09/042.488

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Evans et al.

Group Art Unit: 1633

Application No.:

09/042,488

Examiner: S. Kaushal

Filing Date:

March 16, 1998

Applicant's Representative: Stephen E. Reiter

For:

METHOD FOR MODULATING EXPRESSION OF EXOGENOUS GENES IN MAMMALIAN SYSTEMS,

AND PRODUCTS RELATED

THERETO

# Agenda for Telephone Interview on March 18, 2003

# Discuss rejections under 35 USC § 112, first paragraph, in Office Action mailed 02/11/2003

- I. Possession of the claimed invention
  - discuss grouping of claims and claim components in comparison to allowed claim 71
  - discuss how the specification describes all features required by the present claims
    - in particular:
- (i) similarity of components of claims 50 and 67-70 to claim 71
- (ii) similarity of components of claims 1 and 22-24 to claim 71

## II. Enablement

- discuss support for all of the required elements of the claims as identified above
- discuss disclosure being commensurate with the scope of the claims
- discuss ease of substitution of specifically defined response element in place of ecdysone response element for one of skill in the art
  - discuss potential cancellation of claims 72-77

SALK1520-2 (088802-8752) 09/042,488

# **CLAIM SUMMARY FOR SALK1520-2**

Methods of gene regulation in isolated cells (Claims 1, 3-9, 11-13, 15-24, 39, 40, 47-55, 57-69, 70, and 71)

Claims 1, 3-9, 11-13, 15-21, 39, 40, 47-49, 50-55, 57-66, 70, and 71 (independent in bold) — methods for modulating the expression of an exogenous gene in an isolated cell

Claims 22, 23, 67, and 68

- methods of inducing the expression of an exogenous gene in an isolated cell

Claims 24 and 69

- methods for the expression of a recombinant product detrimental to isolated host cells

# Methods of gene regulation in a mammalian subject (Claims 72-77)

Claims 72 and 75

- methods for modulating the expression of an exogenous gene in a mammalian subject

Claims 73, 74, 76 and 77

- methods of inducing the expression of an exogenous gene in a mammalian subject

# Comparison of allowed claim 71 to other independent claims using isolated cells

Claim	exogenous gene components	relationship	modified receptor components
11	gene under the control of an	modified ecdysone receptor binds to ecdysone	LBD for ecdysteroid
allowed	ecdysone response element	response element in the presence of a ligand	DBD from DNA-binding protein
		(optional silent partner)	activation domain of a transcription factor
		modified receptor has an altered binding	
		specificity as compared to wildtype receptor	
S	gene under the control of an	modified receptor binds to ecdysone response	LBD for ecdysteroid
	ecdysone response element	element in the presence of a ligand (optional	DBD from DNA-binding protein
		silent partner)	activation domain of a transcription factor
		modified receptor does not bind to endogenous	
		response elements	
<i>L</i> 9	gene under the control of an	modified 46dysoute receptor binds to ecdysone	receptor under control of an inducible
	ecdysone response element	response element in the presence of a ligand	promoter
		(optional silent partner)	LBD for ecdysteroid
		modified receptor does not bind to endogenous	DBD from DNA-binding protein
		response elements	activation domain of a transcription factor
89	gene under the control of an	modified octypone receptor binds to ecdysone	LBD for ecdysteroid
	ecdysone response element	response element in the presence of a ligand	DBD from DNA-binding protein
		(optional silent partner)	activation domain of a transcription factor
		modified receptor does not bind to endogenous	
		response elements	
69	gene under the control of an	modified receptor does not bind to endogenous	LBD for ecdysteroid
	ecdysone response element	response elements	DBD from DNA-binding protein
			activation domain of a transcription factor
20	gene under the control of an	modified exalysand receptor binds to ecdysone	LBD for ecdysteroid
	ecdysone response element	response element in the presence of a ligand	DBD from DNA-binding protein
		(optional silent partner)	activation domain of a transcription factor
		modified receptor has substantially no	
		constitutive activity	

# SALK1520-2 (088802-8752) 09/042,488

:

1	ecifically	modified ecdysone receptor binds to ecdysone	LBD for ecdysteroid
	defined response element	response element in the presence of a ligand	DBD from DNA-binding protein
		(optional silent partner)	activation domain of a transcription factor
22	gene under control of a specifically	modified ecdysone receptor binds to defined	receptor under control of an inducible
	defined response element	response element in the presence of a ligand	promoter
		(optional silent partner)	LBD for ecdysteroid
			DBD from DNA-binding protein
			activation domain of a transcription factor
23	gene under control of a specifically	modified ecdysone receptor binds to defined	LBD for ecdysteroid
	defined response element	response element in the presence of a ligand	DBD from DNA-binding protein
		(optional silent partner)	activation domain of a transcription factor
<b>54</b>	gene under control of a specifically		LBD for ecdysteroid
	defined response element		DBD from DNA-binding protein.
			activation domain of a transcription factor

# FOLEY: LARDNER

ATTORNEYS AT LAW

11250 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130 P.O. BOX 80278 SAN DIEGO, CALIFORNIA 92138-0278 TELEPHONE: 858.847.6700 FACSIMILE: 858.792.6773 WWW.FOLEYLARDNER.COM

# FACSIMILE TRANSMISSION

Total # of Pages: 5 (including this page)

TO:	PHONE #:	FAX #:
Examiner Sumesh Kaushal - Art Unit 1636	(702) 205 6020	(703) 746-3124
U.S. Patent and Trademark Office	(703) 305-6838	(desktop fax)

From: Stephen E. Reiter

Sender's Direct Dial: 858.847.6711

Date: March 17, 2003

Client/Matter No: 088802-8752

**User ID No: 1877** 

### **MESSAGE:**

## **UNOFFICIAL**

Re: Application Serial No. 09/042,488

Following are:

Agenda for Telephone Interview on March 18, 2003 (4 pgs.).

If there are any problems with this transmission or if you have not received all of the pages, please call 858.847.6700.

Operator:	Time Sent:	Return Original To:
		Joy Day

CONFIDENTIALITY NOTICE: THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENTS NAMED ABOVE. THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION, AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR ANY AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.